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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/973,035	10/10/2001	Bruno Borsoi	P21548	5050

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
3728	13

DATE MAILED: 05/20/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

EC

<b>Office Action Summary</b>	Application No.	Applicant(s)
	09/973,035	Borsoi et al.
	Examiner	Art Unit
	Anthony D. Stashick	3728

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 20 February 2003.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 19-64 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 19-64 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on 10 October 2001 is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some \* c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

**DETAILED ACTION**

***Specification***

1. The substitute specification submitted on February 20, 2003 has not and will not be entered as it contains new matter. The new matter can be found on pages 6 and 14 of the substitute specification. Specifically, the changing of the term "means" to device creates new matter issues since these terms are not readily interchangeable. For example, fastening means can include hook and loop, snaps, zippers, etc. whereas a fastening device can include any structure that a device might contain such as links, plates, etc.

***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

3. Claims 24, 27, 28 and 29 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the

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claimed invention. Applicant has added the phrase "fixing device" to these claims. This addition is considered new matter, as this limitation was not present in the specification or claims as originally filed. A device implies more structure than that which is encompassed by the term "means".

4. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

5. Claim 57-64 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 57 contains the phrase "...and through a heel of the foot of a wearer." Which renders the claim so. There appears to be no support for this limitation in the claim. Figure 2 shows a plane passing through the fastening area and flexion fold area but does not show it passing through a user's heel. Also, applicant cannot claim a part of the human body in the body of the claim. Therefore, the heel mentioned in the claim should be the heel of the boot or shoe and not the user.

***Claim Rejections - 35 USC § 102***

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

7. Claims 19-24, 28, 29, 32, 34, 36, 38-41, 46-47, 49 are rejected under 35 U.S.C. 102(b) as being anticipated by Cochrane 5,269,078. Cochrane '078 discloses all the limitations of the claims including the following: an article of footwear 11 having a flexible or semi-rigid upper 15; a retention band 10 connected to the inner surface of the upper by at least two anchoring points fixed on lateral and medial sides of the upper (those areas in Figures 1 and 2 where an X appears in the Figures defining the attachment points of the device); the retention band partially surrounding a foot of the wearer of the article of footwear in a flexion fold area of the article of footwear (see Figure 1); at least one of the anchoring points is positioned substantially above the sole (see Figures 1 and 2); at least one of the anchoring points is positioned substantially on a central portion of a line connecting a base of the heel to the flexion fold area of the article of footwear (see Figure 2,

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the central portion of the line being that area between the two end points of the line); one of the anchoring points includes a sliding return (see sliding returns 11, 101, 121 and their corresponding anchoring points); the retention band passes through the sliding return by defining a portion which covers the foot (See Figure 1); the retention band includes a fork (at areas 101 and 121 and the strap portions that anchor them) comprising two arms with one of the arms integrating one of the anchoring points (See Figure 1); the second arm is fixed on an inner surface of the upper by a complimentary anchoring point that is positioned on the same side of the upper as the first anchoring point (Figure 1, any of the anchoring points of 101, 121 or 111); a portion of the retention band includes an attachment mechanism capable of maintaining tension in the tightening mechanism (Figure 2 reference number 80); the attachment mechanism is self-gripping (Velcro®); one of the arms is positioned substantially along a primary direction that passes by the base of the heel and by the flexion fold (that portion of Figure 1 that travels from 61 to 118 to 121 and then to the heel of the boot); another of the arms passes by the flexion fold and in a second direction that is less inclined than the primary direction (that portion from 80 to 11 to 101 to the heel, less inclined because it declines from the flexion

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fold to the heel); the anchoring point which includes the sliding return is positioned on the medial side of the article of footwear (see Figure 1).

8. Claims 19, 20, 31, 36, 49-50 and 57-64 are rejected under 35 U.S.C. 102(b) as being anticipated by Salomon 4,160,332. Salomon '332 discloses all the limitations of the claims including the following: an article of footwear (see Figure 1) having a flexible or semi-rigid upper 17; a retention band 8, 8' connected to the inner surface of the upper by at least two anchoring points fixed on lateral and medial sides of the upper (those areas in Figure 1 anchored at 10' and 16'); the retention band partially surrounding a foot of the wearer of the article of footwear in a flexion fold area of the article of footwear (see Figure 1); at least one of the anchoring points is positioned substantially above the sole (see Figure 1); one of the anchoring points including a sliding return 16'; the retention band, which is fixed to the upper at an end to a second of the anchoring points, passes in the sliding return by defining a portion which covers the foot (see Figure 1); the retention band includes at least one distribution plate 1 fixed in the area of the flexion portion beneath the retention band.

9. Claims 19, 20, 23 and 24 are rejected under 35 U.S.C. 102(b) as being anticipated by Young 1,650,000. Young

'000 discloses all the limitations of the claims including the following: an article of footwear (see Figure 1) having a flexible or semi-rigid upper 1; a retention band 5, 6 connected to the inner surface of the upper by at least two anchoring points 2 fixed on lateral and medial sides of the upper; the retention band partially surrounding a foot of the wearer of the article of footwear in a flexion fold area of the article of footwear (that are of the instep of the user's foot); at least one of the anchoring points is positioned substantially above the sole (see Figure 1); the retention band includes a fork 8 comprising two arms; one of the arms integrating one of the anchoring points (see Figure 1); the second of the arms is fixed on the inner surface of the upper by a complementary anchoring point that is positioned on the same side of the upper as the first anchoring point (either of the arms in Figure 1); a portion of the retention band, comprised between a sliding return (portion 7 of 8) and an end of the retention band, includes an attachment mechanism capable of maintaining tension in the tightening mechanism (see col. 2, lines 73-97).

***Claim Rejections - 35 USC § 103***

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

11. Claims 26-27, 41-45, 48-49 and 55 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 24 and 36 above in view of the French reference to Branger 2,615,074 (Branger '074). The references as applied to claims 24 and 36 above disclose all the limitations of the claims except for the retention band including an attachment mechanism means that is complimentary to the attachment mechanism and the inner surface of the upper having an attachment mechanism that is complimentary to the attachment mechanism. Cochrane '078 teaches that the surface of a shoe upper can have attachment means that is complimentary to the attachment means on the band to allow for adjustability of the strap. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place complimentary attachment means, such as that taught by

Cochrane '078, on the inner surface of the references as applied to claims 24 and 36 above to keep the ends of the strap inside the boot and prevent fraying or accidental detachment of the strap during use. Branger '074 teaches that complementary attachment means to that attached to a band can also be attached to the band itself to allow for adjustability of the band and allow for tightening. Therefore, it would have been obvious to place complimentary attachment mean, such as that taught by Branger '074, on a portion of the band to allow for the band to attach to itself and allow for adjustment and tightening of the band.

12. Claims 25, 30 and 37 are rejected under 35 U.S.C. 103(a) as being unpatentable over the references as applied to claims 19, 24, and 36 above in view of Bergeron 5,832,632. The references as applied to claims 19, 24 and 36 above disclose all the limitations of the claims except for the article of footwear having an inner shoe with at least two raising elements fixed on the lateral and medial sides allowing for the retention band to take support on the raising elements. Bergeron '632 teaches that a boot with a retention band can allow for another shoe to be placed within the boot. The shoe placed within the boot can have raising sections (the side edges of the shoe where the laces are located) that allow for the retention band to be

supported thereon (see Figure 1). Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place a shoe within the boot, with raised section on the shoe, as taught by Bergeron '632, to allow for the boot to protect the shoe and allow for tightening of the boot to the shoe without creating extra pressure on the user's foot during use.

13. Claims 33, 35, and 51-54 are rejected under 35 U.S.C. 103(a) as being obvious over Cochrane 5,269,078 as applied to claims 22 and 32. Cochrane '078 discloses all the limitations substantially as claimed. With respect to claim 33, the location of the anchoring points of the band can be on either side of the shoe, as shown by Cochrane '078, and therefore, it would have been obvious to fix the arms on the medial side of the footwear as it appear it would be a mere matter of change of location of the fixation points of the band. With respect to claim 35, the housing in the upper would be the slit in the upper in which the band passes through.

***Response to Arguments***

14. Applicant's arguments filed February 20, 2003 have been fully considered but they are not persuasive. Applicant argues that there appears to be no single strap in Cochrane that

extends in the manner claimed. It appears applicant is arguing more than that which is claimed. Applicant has not claimed a "single" strap but has claimed a retention band. A retention band can be made of multiple pieces and therefore, the claimed limitations are met by the applied art. Applicant also argues that the retention band of Cochrane does not extend in the rearward direction and pull the heel to the heel cup as claimed. This is also not clearly understood. The band of Cochrane extends in a diagonal direction. When broken down into its two forces, the band pulls the foot downward and to the rear of the boot, thereby meeting the limitations of the claims. Applicant also argues that the straps of Cochrane do not extend toward the heel but to a point in front of the heel, this is not clearly understood. The claim only requires that it extend in a direction toward the heel and not through a point in the heel, therefore, the strap of Cochrane extending toward the heel meets this limitation. Applicant further argues that Cochrane does not teach a two-armed fork as claimed. This limitation is pointed out in the rejections noted above. With respect to applicant's argument directed to the housing, it appears applicant is arguing more than that which is claimed. The slit of Cochrane is located on the inner surface of the upper "in an area where the slide return is located" as required by the

claim. There appears to be no limitation that the slide return is "housed in such housing".

With respect to applicant's arguments that the FR '074 reference teaches away from applicant's invention, it appears applicant is arguing more than that which is claimed. Applicant states that the claimed invention pulls the user's foot towards the heel. The invention of Fr '074 also pulls the user's foot towards the heel of the shoe, even though it may also pull it towards the sole. A strap that is angled in a manner such as that shown in FR '074 has two force vectors, one in the horizontal direction and the other in the vertical direction. In this instance, the force vector in the vertical direction pulls the user's foot to the sole but the force vector in the horizontal direction pulls the user's foot to the heel of the boot/shoe.

In regards to applicant's argument that the boot of Salomon is rigid and not semi-rigid as claimed. This argument is not clearly understood. In lines 12-18 of Salomon, the boot is described as being relatively rigid which would meet the limitation of being semi-rigid. With respect to applicants arguments directed to the attachment of the strap to the inner boot of Salomon, applicant's claims only require the strap to be attached to the inner surface of the boot, it does not make

clear whether the boot claimed is an inner boot or outer boot as noted by applicant.

With respect to applicant's arguments that the straps of Young are not a tightening mechanism and do not "surround" the foot, this argument is not clear. In as much as the straps of the applicant's invention only surround the foot of the user on the top and sides, the straps of young surround the foot of the user on the bottom and sides. With respect to the tightening mechanism, as the user's foot is placed within the shoe, the straps pull on the sides and "tighten" the upper to the user's foot, thereby being a tightening mechanism.

#### *Conclusion*

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL.** See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened

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statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Telephone inquiries regarding the status of applications or other general questions, by persons entitled to the information, "should be directed to the group clerical personnel and not to the examiners. In as much as the official records and applications are located in the clerical section of the examining groups, the clerical personnel can readily provide status information without contacting the examiners", M.P.E.P. 203.08. The Group clerical receptionist number is (703) 308-1148.

If in receiving this Office Action it is apparent to applicant that certain documents are missing, e.g., copies of references cited, form PTO-1449, form PTO-892, etc., requests for copies of such papers or other general questions should be directed to Tech Center 3700 Customer Service at (703) 306-5648, email [CustomerService3700@uspto.gov](mailto:CustomerService3700@uspto.gov).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony D. Stashick whose telephone number is 703-308-3876. The examiner can normally be reached on Monday-Thursday, 6:00 am until 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 703-308-2672. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

Other helpful telephone numbers are listed for applicant's benefit.

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Anthony D. Stashick  
Primary Examiner  
Art Unit 3728

ADS  
May 17, 2003